Amendments to the Drawings:

Please replace the drawing, labeled FIG. 4 with the replacement sheet of drawings enclosed herewith.

REMARKS

The present application has been reviewed in light of the Office Action mailed October 10, 2007. Claims 1-19 are presently pending, of which, claims 1, 6, 10, 16, and 17 have been amended herein, and claim 19 having been added herein, claims 1 and 10 being in independent form. Reconsideration of the present application, as amended, is respectfully requested in view of the following remarks.

Applicant has amended paragraph [0040], of the specification to correct minor inconsistencies therein. No new matter has been added by these amendments.

The drawings, namely FIG. 4, have been amended herein in such a manner so as to bring the specification and drawings into conformity with each other. Enclosed herewith please find a replacement sheet of drawings, including FIG. 4.

Claim Rejection under 35 U.S.C. § 112

The Examiner has rejected claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, "the electrosurgical generator control circuitry", as recited in said claim, lacks antecedent basis. Applicant has amended said claim such that there is now proper antecedent basis for said recitation.

Accordingly, Applicant respectfully submits that the rejection of claim 16 under 35 U.S.C. 112, second paragraph, has been overcome and should be withdrawn.

Claim Rejections under 35 U.S.C. § 103 (a)

Claims 1-15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lebouitz et al. (6,494,882) (hereinafter Lebouitz) in view of Burek (6,361,532) (hereinafter Burek). Applicant traverses the Examiner's assertion and respectfully submits that neither Lebouitz nor Burek render claims 1-15 unpatentable for at least the following reasons.

According to § 2143.03 of the MPEP, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." It is Applicant's position, that all the claim limitations of amended independent claims 1 and 10, of the above-referenced application, are not taught or suggested, either expressly or implicitly, by any of the above citied art of record.

Claim 1 recites an electrosurgical pencil including a strain gauge affixed to the electrocautery blade for measuring a displacement of the blade, wherein the strain gauge is sensitive to a temperature change associated with the electrocautery blade; and a compensator resistor operatively connected to the strain gauge, wherein the compensator resistor is configured to compensate for changes in temperature of the electrocautery blade that effect the strain gauge.

Also, Claim 10 recites an electrosurgical instrument including a strain gauge in communication with the electrocautery blade for measuring a displacement of the electrocautery blade, wherein the strain gauge is sensitive to a temperature change associated with the electrocautery blade; and a compensator resistor operatively

connected to the strain gauge, wherein the compensator resistor is configured to compensate for changes in temperature of the electrocautery blade that effect the strain gauge.

According to the present disclosure, wherein changes in temperature in blade 16 are likely, it is contemplated that strain gauge 30 be provided with a compensator resistor 34, placed in close proximity to the strain gauge. Preferably, resistor 34 is configured to compensate for the changes in temperature experienced by blade 16 which are measured by strain gauge 30. (see para. [0032]).

Conversely, Lebouitz discloses, the use of a sensor element 30 bonded into a recess 20 of a blade 10. (see col. 6, lines 44-45). Sensor element 30 includes a multitude of sensors 40 formed on a substrate 35. Lebouitz discloses that the sensors 40 may comprise one of the well known types of sensors described therein, for example, a strain sensor, a pressure sensor, a temperature sensor, a density sensor, a motion sensor, or any other sensing device that can be formed on semiconductor substrate 35. (see col.5, lines 29-36).

The Examiner states that Lebouitz discloses that temperature may also be monitored in addition to strain. The Examiner then goes on to maintain that "it would have been further obvious to compensate the strain signal based on temperature since Lebouitz et al. recognize that temperature is a factor in the monitoring of various parameters." (see October 10, 2007 Office Action).

Applicant respectfully disagrees with the Examiners conclusion. While Applicant acknowledges that Lebouitz discloses the use of temperature sensors, Applicant disagrees that Lebouitz sufficiently discloses any compensation for the changes in temperature experienced by the blade. Applicant respectfully submits that the Examiners holding that "it would have been further obvious to compensate the strain signal based on temperature since Lebouitz et al. recognize that temperature is a factor in the monitoring of various parameters," constitutes impermissible hindsight as the Examiner has failed to provide evidentiary support from the references in establishing such a holding.

The Examiner relies on Burek for the teaching of an electrosurgical pencil that includes an activation switch. Applicant submits that Burek fails to cure the deficiencies of Lebouitz in that Burek fails to disclose a compensator resistor operatively connected to the strain gauge, wherein the compensator resistor is configured to compensate for changes in temperature of the electrocautery blade that effect the strain gauge, as called for in claims 1 and 10.

Since Lebouitz or Burek, taken alone or in any proper combination, do not teach or suggest each and every element as set forth in claims 1 and 10, as required by MPEP § 2143.03, the rejection of claims 1 and 10 under 35 U.S.C. § 103(a) should be withdrawn.

Since claims 2-9 and 11-15 depend, directly or indirectly, from claims 1 and 10, respectively, and contain all of the features of claims 1 and 10, and for the reasons claims 1 and 10 are patentable, Applicant respectfully submits that claims 2-9 and 11-15 are also patentable over Lebouitz in view of Burek.

Claims 10, and 16-18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Lebouitz in view of Burek as applied to claim 10, and in further view of Bell et al. (WO 9639086) (hereinafter Bell). Applicant submits that each of claims 10 and 16-18 is allowable under 35 U.S.C. 103 (a) over Lebouitz in view of Burek and further in view of Bell because the combination of Lebouitz, Burek and Bell fails to render claim 10 obvious.

The Examiner relies on Bell for the teaching of modifying the generator output based on strain gauge input.

Applicant respectfully submits that Bell does not cure the deficiencies of Lebouitz in that Bell fails to disclose a compensator resistor operatively connected to the strain gauge, wherein the compensator resistor is configured to compensate for changes in temperature of the electrocautery blade that effect the strain gauge, as called for in claim 10. Accordingly, Applicant submits that claim 10 is allowable under 35 U.S.C. 103 (a) over Lebouitz in view of Burek and further in view of Bell.

Since claims 16-18 depend, directly or indirectly, from claim 10 and contain all of the features of claim 10, and for the reasons claim 10 is patentable, Applicant respectfully submits that claims 16-18 are also patentable over Lebouitz in view of Burek and in further view of Bell.

CONCLUSION

New claim 19 has been added herein. Applicant submits that new claim 19 is fully supported by the specification.

Applicant further submits that new claim 19 is allowable over the art of record in that the art of record fails to anticipate or render obvious an electrosurgical instrument, comprising a housing; an electrocautery blade supported within the housing and extending partially therefrom, the blade adapted to connect to an electrosurgical generator which provides electrosurgical energy to the blade; an activation switch coupled to the generator which permits selective activation of the electrocautery blade; a strain gauge in communication with the electrocautery blade for measuring a displacement of the electrocautery blade; and a drag evaluation circuit operatively connected to the strain gauge, wherein the drag evaluation circuit receives electrical signals from the strain gauge, compares said electrical signals against known values, and transmits a corresponding evaluation signal to an electrosurgical generator, wherein the electrosurgical generator adjusts at least one parameter to compensate for at least one of an increase, a decrease and a non-change in displacement of the electrocautery blade.

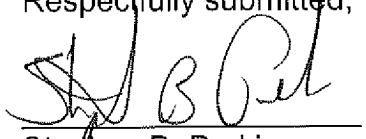
In view of the foregoing remarks and/or amendments, reconsideration of the application and allowance of claims 1-19 is earnestly solicited.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicants' undersigned representative at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,



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